UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,811	09/05/2003	Carey E. Garibay	ORACL-01454US2	7109

80548   7590   11/25/2008

Fliesler Meyer LLP
650 California Street
14th Floor
San Francisco, CA 94108

EXAMINER
JOHNS, CHRISTOPHER C

ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
11/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/655,811	GARIBAY ET AL.
	Examiner	Art Unit	
	Christopher C. Johns	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *03 November 2008*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-30* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date *11/03/08, 9/16/08, 8/21/08, 8/11/08*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   Claims 1-30 are pending.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 1-10 are rejected under 35 U.S.C. §101 because the claimed invention is directed

to non-statutory subject matter.

4.   Based on Supreme Court precedent[1] and recent Federal Circuit decisions, a §101 process

must (1) be tied to a machine (e.g. a particular apparatus) or (2) transform underlying subject

matter (such as an article or materials) to a different state or thing.[2] If neither of these

requirements is met by the claim(s), the method is not a patent eligible process under 35

U.S.C. §101.

5.   In this particular case, the method in independent claim 1 is not tied to a particular

apparatus, nor does it transform underlying statutory subject matter.

Claim Rejections - 35 USC § 103

---

[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).
[2] The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States

Patent Application Publication 2004/0158709 ("Narin"), in view of Microsoft Windows Media

Player, further in view of Wolfram MathLM, as referenced in "Mathematica 4 Documentation"

("MathLM").

8.   As per claims 1, 11, and 21, Narin discloses:

9.   maintaining digital records of software licenses for multiple groups (¶136 – "a directory

lists for each requestor not only the identifier thereof but also the identifier of each

group/cluster/division/platform/other entity/etc. that the requestor is a member of"), the digital

records indicating rights (Figure 3, reference number 308) associated with software licenses

(Figure 3, reference number 310);

10.   accessing a group administration application to set access rules for members of a group,

controlling access of digital record data of the group by members of the group (¶119 – "In such a

situation...a rights template is created that the user can repeatedly employ in connection with

creating rights labels...[to apply to sets] of users or classes..."; ¶123 – "rights template may be

used to limit the scope or type of rights labels that can be created...may be pre-defined as policy

that a particular user should always publish content to a particular class of users only...");

11.   using access rules to determine whether to allow a member of the group to view digital

record data (inherent in the art of software licensing, as this allows the system to protect the data

it attempts to protect, and inform the users of their rights under the licensing scheme; also see

¶60 - "a content owner…wishes to restrict what the user can do with such distributed digital

content…may wish to restrict the user from copying and re-distributing such content to a second

user…"; ¶62 – "allows an owner of digital content to specify license rules that must be satisfied

before such digital content is allowed to be rendered on a user's computing device…"; finally,

see generally ¶48, ¶49, ¶58-67, ¶71, and ¶72).

12.   Narin does not explicitly disclose:

13.   when the member is allowed to view the digital record data, displaying the data including

displaying a right associated with one of the software licenses;

     a.   Microsoft Windows Media Player discloses a way for users to view the rights that

have been granted – see "Microsoft Windows Media – Troubleshooting Windows Media

Player 9 Series Error Messages" (hereafter WMP), subheading "C00D2720: Cannot copy

the file". WMP teaches this to allow users to know which rights that they are afforded

for any file. This allows the user to understand what he may and what he may not do

with said file.

     b.   Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the invention in Narin to allow users to view the rights

they are afforded (as in WMP) because it would allow a more usable and convenient

system for the users. Allowing users to know which rights they have in a certain file has

the advantage of allowing users to understand which files may be copied and which may

not be copied – a person having ordinary skill in the art would appreciate this as an

advantage because it enables a more informative system.

14.   wherein the access rules are used to determine whether to allow the member to lock the

software associated with the one of the software licenses to a new IP address, in response to

member input, locking the software associated with the one of the software licenses to the new

IP address.

        c.   Neither Narin nor Windows Media Player explicitly disclose that access rules are

        used to determine whether a user may lock a software to an IP address, nor locking the

        software to a new IP address.

        d.   MathLM teaches determining whether users may acquire licenses (the Examiner

        asserts that this was well-known to those skilled in the art at the time of the invention;

        regardless, see "Writing a Restriction Script", "Defining the Terms", part 5 - "the list of

        machine names or domains that are allowed to connect". As users may only access the

        system when using a "machine" (a computer), this determines whether users are able to

        acquire licenses to begin with).

        e.   MathLM also teaches "locking the software…to [a] new IP address" (the

        Examiner asserts that it was well-known to those skilled in the art at the time of the

        invention to allow for both "checkin" and "checkout" of licenses - users may request a

        license ("checkout") before they wish to use the program in question, and may return

        ("checkin") the license when they are finished with the program; regardless, see "Using

        MonitorLM", page 11 - "The resulting output has the form shown

below…Authorized…Available…Checked Out", page 8, "%PROC_IP…IP address of machine taking Mathematica process").

f.   If a user were to utilize the software package on computer A (with IP address Ax) and then not wish to use it on his computer anymore, he can "checkin" the license (sending it back to the server), which removes the lock tied to machine A, IP address Ax. Then, if the user goes to another computer, computer B (with IP address Bx) and attempts to use the software, the software will ask for a new license ("checkout"), tied to machine B, IP address Bx. This has the advantage of requiring fewer licenses than would otherwise be necessary, were each user to possess his own license (see "Benefits of Using *Network Mathematica*" - "if no more than 10 users in a facility of 50 access *Mathematica* concurrently, a 10-seat *Network Mathematica* can replace 50 single-user copies").

g.   Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Narin and Windows Media Player to utilize access rules to determine whether a user may lock software to a new IP address, and to allow for locking the software to a new IP address, because it will result in a less-expensive system to administer and use. A person having ordinary skill in the art would see this as advantageous because it does not materially affect the usability of the program, but results in decreased cost-of-use.

15.   As per claims 2, 12, and 22, Narin discloses:

16.   access rules set to allow some group members to see but not modify software license data

(¶110 – "the SRL can be republished if the user of the content has been granted sufficient

permission to do so. That is, if allowed, the user may alter rights data within the SRL…").

17.   As per claims 3, 13, and 23, Narin discloses:

18.   access rules set to restrict access based upon inputted field information to some group

members (figure 12, reference numbers 1202, 1204, 1216).

19.   As per claims 4, 14, and 24, Narin discloses:

20.   access rules set to restrict access based on inputted field information (figure 12, reference

numbers 1202, 1204, 1216).

21.   As per claims 5, 15, and 25, Narin discloses:

22.   group administration application is used to require group members to input field data

(¶94 - "license issuing entity can be configured to use protocol…e.g.…user-id-and-password

scheme").

23.   As per claims 6, 16, and 26, Narin discloses:

24.   selected access rules allows a group member to access a digital record and adjust the

rights associated with the software license (¶110 – "the SRL can be republished if the user of the

content has been granted sufficient permission to do so. That is, if allowed, the user may alter

rights data within the SRL…"; MathLM also discloses this, see "Writing a Restriction Script",

page 1, "allow from…deny from…").

25.   As per claims 7, 17, and 27, Narin discloses:

26.   group administration application produces reports concerning software licenses of the

group (claim 25, "locating the listing for the group in the directory based on the identifier of the

group…"; MathLM also discloses this, see "Using MonitorLM", page 11 - "the resulting output

has the form shown below").

27.   As per claims 8, 18, and 28, Narin discloses:

28.   group administration application is part of a web based application (¶57 - "In a network

environment in which the communications network/bus 14 is the Internet, for example, the

servers 10 can be Web servers with which the clients…communicate via any of a number of

known protocols such as HTTP").

29.   As per claims 9, 19, and 29, Narin discloses:

30.   web application uses role based security (Narin mentions using an "administrator" in at

least ¶107, ¶124, ¶126, and ¶131. This is an example of "role based" security).

31.   As per claims 10, 20, and 30, Narin discloses:

32.   configuration information for the computers running software associated with the

software licenses are stored in the digital records (figure 11, reference numbers 13, 16, "rules and

requirements").

33.   Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narin in

view of Windows Media Player, further in view of MathLM, further in view of "FLEXlm End

Users Guide, Version 8.0" ("FLEXlm").

34.   It is the examiner's primary position that the claims are anticipated because of the above

disclose features (i.e. locking a license to an IP address)[3]. However, if not inherent, then

FLEXlm teaches tying licenses to IP addresses (page 49-50 - "Anywhere a host name can be

used in an options file, an IP-address of the format #.#.#.# can be used instead (v8.0+ vendor

daemon). The IP-addresses can contain wildcards"), in order to determine which features and

permissions are available to which users/workstations/IP addresses. This is done in order to

more granularly mete out licenses, so groups and their associated permissions can be formed

around identities such as IP addresses. Therefore, it would have been obvious to one of ordinary

skill in the art at the time of the invention to modify Narin to lock licenses to IP addresses, as in

FLEXlm, because it would create a more finely-controllable system. A person having ordinary

skill in the art would see this as advantageous because it would enable a more finely-controlled

system, where groups could be defined in a stricter and more granular sense.

---

[3] MPEP §2112.III authorizes a secondary 35 USC §103 rejection, when the "the composition of the prior art is the
same as that of the claim but the function is not explicitly disclosed by the reference". While the Examiner feels that
the prior art explicitly discloses the claimed invention, a second §103 rejection has been made in order to expedite
prosecution.

Response to Arguments

35.   Applicants' arguments filed 16 September 2008 have been fully considered but they are

not persuasive.

36.   Applicants argue that "Wolfram MathLM only envisions that the administrator…be able

to control which machines can access a license". In a sense, this is true - the administrator of the

system must either explicitly or implicitly allow users to acquire licenses. However, much like

driving a car requires a driver's license, the license does not necessarily mean that the holder is

driving at any point in time - i.e.: if the user does not attempt to use one of these machines that is

permitted to access a license, then the machine will never access a license. The idea of "checkin"

and "checkout" was well-known to those skilled in the art at the time of the invention, and allows

for users to determine which computer will receive a license, merely by requesting the license at

that machine.

37.   Applicants further argue that the right to change the IP lock is a "delegation" to a user. It

is noted that this "feature" is not actually in the claims, instead noting that the member of the

group may "lock the software...to a new IP address". No idea of delegation explicitly appears in

the claims. In addition, none of the claims recite the ability to "allow...certain trusted group

members to change the IP lock", while preventing certain other users. Access rules are

consulted, but this *is* covered in MathLM, as a user who cannot access the system because of an

explicit/implicit denial will not be able to checkin/checkout a license (see above). See *In re Van*

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

38.   **Examiner's Note:** Although Examiner has cited particular columns, line numbers and

figures in the references as applied to the claims above for the convenience of the applicant(s),

the specified citations are merely representative of the teaching of the prior art that are applied to

specific limitations within the individual claim and other passages and figures may apply as well.

It is respectfully requested that the applicant(s), in preparing the response, fully consider the

items of evidence in their entirety as potentially teaching all or part of the claimed invention, as

well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Furthermore, it must be noted that the documents cited on any enclosed PTO-892 or PTO-1449

form are cited in their entirety.

39.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

40.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

41.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462.

The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

42.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

43.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

                                        Christopher C Johns
                                        Examiner
                                        Art Unit 3621

CCJ

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685